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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,208	05/10/2001	Jian Chen	P1381R1D1	8512

9157 7590 02/24/2003

GENENTECH, INC.
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SOUTH SAN FRANCISCO, CA 94080

EXAMINER

JIANG, DONG

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 02/24/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,208

Applicant(s)

CHEN ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2002 and 23 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED OFFICE ACTION

Applicant's amendment in paper No. 14, filed on 29 October 2002 is acknowledged and entered. Following the amendment, claims 60-65 are canceled, claims 67-69 are amended, and the new claims 71-82 are added.

Applicant's supplemental amendment in paper No. 15, filed on 23 January 2003 is acknowledged and entered. Following the amendment, claims 69, 71, 74-76, 79 and 80 are amended.

Currently, claims 66-82 are pending and under consideration.

Withdrawal of Objections and Rejections:

All objections and rejections of claims 60-65 are moot as the applicant has canceled the claims.

The objection of claims 67 and 68 is withdrawn in view of applicant's amendment.

The scope rejection of claims 69 and 70 under 35 U.S.C. 112, first paragraph is withdrawn in view of applicant's amendments.

Rejections Over Prior Art:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 66-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Ebner et al., US 2003/0003545.

Ebner discloses a polypeptide of IL-21, which has the amino acid sequence of SEQ ID NO:29, and is 100% identical to SEQ ID NO:3 of the present invention (see appended computer printout of sequence search result). Further, Ebner teaches a pharmaceutical composition comprising the polypeptide (page 54, Example 23), and a kit comprising the composition (page 55, [0439]). The reference, therefore, anticipates the polypeptide and the composition thereof in the present claims 66-68 and 71-80, and the kit of claims 69 and 70. With respect to the functional limitation of capable of inducing the production of TNF- α in THP-1 cells (claims 69 and 71, for example), and for treatment of a degenerative cartilaginous disorder (claim 70), they are either a inherent property of the same composition, or an intended use of the claimed composition, and do not alter the nature of the composition. Therefore, such claim limitations add no patentable weight to said composition. Additionally, With respect to claim 70, the informational content of the printed matter is not given weight, and does not render the article patentably distinct from the teachings of Ebner. Furthermore, Ebner teaches a fusion protein comprising said polypeptide fused to antibody domains such as an antibody Fc region (page 30, [0172]), thus, the reference also anticipates claims 81 and 82.

Conclusion:

No claim is allowed.

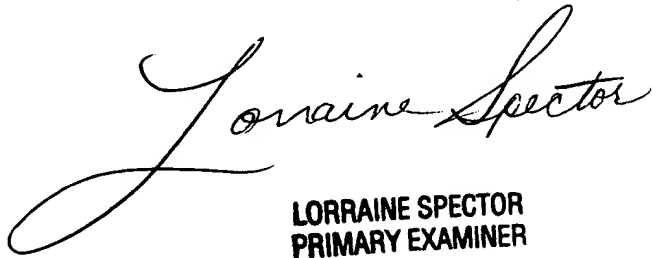
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Advisory Information:

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


**LORRAINE SPECTOR
PRIMARY EXAMINER**

Dong Jiang, Ph.D.
Patent Examiner
AU1646
2/3/03